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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,526	08/24/2001	David J. Boothby	042933/326776	2484

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EXAMINER

VON BUHR, MARIA N

ART UNIT	PAPER NUMBER
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2121

MAIL DATE	DELIVERY MODE
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09/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/939,526	Applicant(s) BOOTHBY, DAVID J.	
	Examiner M.N. VON BUHR	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>(x12)</u> see <i>Office action</i> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner acknowledges receipt of Applicant's preliminary amendment, received 25 March 2002; which amends claims 1, 24 and 48. Claims 1-58 remain pending in this application.
2. Examiner acknowledges receipt of Applicant's response to the 37 CFR 1.105 requirement for additional information. This response is deemed to satisfy the requirement.
3. Examiner acknowledges receipt of Applicant's information disclosure statements, received 3/25/2002, 10/24/2002, 5/14/2003, 9/9/2003, 11/24/2003, 1/13/2005 and 3/23/2006, with accompanying reference copies. These submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, they have been taken into consideration for this Office action.
4. Examiner acknowledges receipt of Applicant's formal drawings, received 18 June 2002. These drawings are acceptable.
5. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP §1410.01.

In this case, the Assent of Assignee submitted on 25 March 2002 was not accompanied by a submission in accordance with the provisions of § 3.73(b) as required by 37 CFR 1.172(a). Accordingly, a proper assent of the current assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

6. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,943,676 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§1404, 1442.01 and 1442.04.

7. In response to this Office action, Applicant is required to provide the Office with information pertaining to the status/resolution of the litigation involving Patent No. 5,943,676, referred to by documents submitted with the Information Disclosure Statement of 09 September 2003.

8. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP §1414) because of the following:

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to Applicant's belief that the original patent is wholly or partly inoperative or invalid by reason of (1) a defective specification (or drawing) or (2) by reason of the patentee claiming more or less than the patentee had a right to claim in the patent. See 37 CFR 1.175(a)(1) and see MPEP §1414. In this case, although Applicant has included the statement "that the aforesaid patent is partly inoperative by reason of obvious errors in the language of some of the claims," this statement does not fall within either of the options listed above. In this regard, Examiner deems the errors specified by Applicant to render the patent partly inoperative by reason of claiming more than what patentee had a right to claim, because the patented claims have no support within the originally filed specification (i.e.; there is no disclosed support, satisfying 35 U.S.C. §112, first paragraph, for the patented claim limitation of "performing a comparison of the set of non-recurring records of the first database to a recurring record of the first database").

The reissue oath/declaration filed with this application is further defective because it fails to contain a statement that "*all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the Applicant.*" See 37 CFR 1.175 and MPEP §1414.

In addition, the reissue oath/declaration signed by inventor is not in compliance with 37 CFR 1.63(b)(3), as required by 37 CFR 1.175(a) and MPEP §1414. Specifically 37 CFR 1.63 (b)(3) requires that the oath or declaration must state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56, whereas in the declaration filed March 25, 2002 Mr. David Boothby, the sole inventor, only acknowledges the duty to disclose information...in accordance with 37 CFR §1.56(a) and not the rule as a whole.

Claims 1-58 are rejected as being based upon a defective reissue declaration under 35 U.S.C. §251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M.N. Von Buhr whose telephone number is 571-272-3755. The examiner works a part-time schedule and can normally be reached on Monday-Tuesday (9am-7pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M.N. VON BUHR/
Primary Examiner, Art Unit 2121

MNVB
4/22/10